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REMARKS/ARGUMENTS

Claims 1 – 10, 12, 17, 19 – 22, and 24 are pending in the application. Claims 1 – 10, 12, 17, 19 – 22, and 24 stand rejected. Claims 13 – 16 have been cancelled in view of a restriction requirement and claims 11, 18, and 23 have been cancelled for other reasons. No claims are amended or cancelled herein. All rejections are addressed below.

Rejection Under 35 U.S.C. §103 in view of Gleim '671 combined with Hirosaki '050

Claims 1 – 10, 12, 17, 19 – 22, and 24 stand rejected under 35 U.S.C. §103 in view of Gleim '671 combined with Hirosaki '050.

Claims 1 and 17 (and all other claims by dependency) recite a substrate layer consisting essentially of a woven fiber material. The woven fiber material is the preferred substrate layer described in the specification (page 4, line 26 to page 5, line 4), and the “consisting essentially of” language in claims 1 and 17 was used to distinguish the substrate of the claimed invention from substrates having resin impregnated fabrics, such as the substrate layer of Hirosaki, as set forth by the Amendment dated October 1, 2003.

In particular, the cited references, alone or in combination, do not disclose, teach, or suggest the use of a non-impregnated woven fabric substrate layer, and the Office has not disputed that the invention is distinguishable from the cited references on that basis. However, the Office has refused to give consideration to the “consisting essentially of” language used by Applicant until Applicant can demonstrate that resin impregnation of the fabric layer would materially affect the basic and novel characteristics of the material. (¶4 of Office Action).

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The specification describes that "The fiber of the substrate is preferably not employed within a resin, though a fiber reinforced resinous material may also be used as the substrate. The preferred woven fiberglass substrate layer provides extra strength to the laminate, and prevents tearing of the laminate when stressed, such as when the laminate is being pulled away from an adhesive attachment to a solid surface." (page 4, line 26 to page 5, line) Thus, the application distinguishes the non-impregnated fabric as the preferred embodiment and then demonstrates the advantage of the preferred non-impregnated fabric over the alternative impregnated fabric substrate.

As further evidence that impregnation of the substrate layer would have a material affect on the characteristics of the decorative laminate, a declaration of John L. Levenda, inventor of the application, is attached. The declaration highlights the manner in which the resin matrix would materially affect the basic and novel characteristics of the claimed laminate.

It is submitted that Applicant has met the burden of showing the material affect of adding a resin matrix to the woven fabric layer of the claimed substrate layer. Therefore, the claim recitations of "consisting essentially of" in claims 1 and 17 must be given patentable weight. Since the claims, as written, are distinguishable from the cited references, it is respectfully requested that the pending 35 U.S.C. §103 rejection be withdrawn.

Conclusion

In view of the above remarks, all rejections have been addressed and overcome. It is respectfully submitted that the claims are in condition for allowance, and allowance of the claims is requested.

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It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

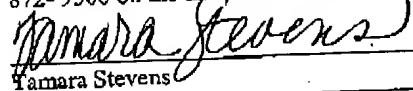
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Tamara Stevens

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